

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 19

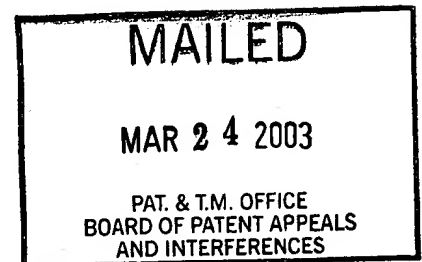
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MEREL EPSTEIN

Appeal No. 2002-1030
Application No. 09/603,222

ON BRIEF



Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 7 and
8, which are all of the claims pending in this application.

We AFFIRM-IN PART.

BACKGROUND

The appellant's invention relates to a balancing appliance for a footwear item. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shaw	1,958,097	May 8, 1934
Cherniak	3,099,267	Jul. 30, 1963
Marc	5,068,983	Dec. 3, 1991
Kantro	5,170,572	Dec. 15, 1992
Smith	5,345,701	Sep. 13, 1994

Claims 1, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kantro in view of Cheriak.

Claims 1, 7 and 8 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Kantro in view of Cheriak, Shaw, Smith and Marc.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 14) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 13^{1/2}) for the appellant's arguments thereagainst.

¹A rejection of claims 1, 7 and 8 under the judicially created doctrine of obviousness-type double patenting was withdrawn after a terminal disclaimer was filed, and a rejection of claims 1, 7 and 8 under 35 U.S.C. § 112, second paragraph, was withdrawn in the Answer.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The specification describes the invention in the following manner:

The present invention, as detailed below, provides a universal device appliance or balancing disc for providing balance and weight distribution adjustment which is easily integrated with existing orthotic foot devices as well as into other footwear items or devices. In accordance herewith, there is provided a wedge-shaped circular disc, which is particularly adapted to be securable to an orthotic plate in a plurality of incremental orientations through a 360° arc in both the posterior and anterior portions of the orthotic device to provide the requisite adjustment for effecting proper balance and weight distribution. Similarly, the present appliance can be used in conjunction with insoles or be directly attached to a footwear item such as a shoe, sandal, etc. (page 2).

The angular inclination enables compensation for balance, depending upon a user's foot (page 3).

The present device can be made from any suitable material, such as a flexible rubber, synthetic resinous material, or the like (page 3).

. . . of a flexible rigid or semi-rigid material, such as a foam, leather, steel, plastic or the like (page 4).

The disc 16 hereof is a substantially circular solid wedge member made of either rigid, semi-flexible or flexible material, such as plastic, rubber, synthetic rubber or the like, as required, prescribed and/or desired (page 5).

Claim 1 reads as follows:

1. A balancing disc for an orthotic foot device comprising:

a substantially circular member having a planar top surface and a planar bottom surface, the surfaces being inclined at an angle with respect to each other, the disc being securable to the orthotic foot device in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution.

Both of the rejections are under 35 U.S.C. § 103. The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The question under 35 U.S.C. §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co. v. Biotech Labs., Inc. 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozak, 416 F.2d 1385,

1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Looking to claim 1, the examiner's first rejection is that the subject matter recited therein would have been obvious to one of ordinary skill in the art in view of the combined teachings of Kantro and Cherniak. The appellant has set forth several arguments in rebuttal to this conclusion, but they have not persuaded us that the rejection of claim 1 should not be sustained. Our reasoning follows.

Kantro is directed to a foot support insole the purpose of which is to correct problems resulting from the change in a person's balance caused by such factors as an increase in weight (column 1, line 11 et seq.). Thus, like the appellant, Kantro is concerned with the wearer's balance. To this end, Kantro's invention provides a means for cushioning and supporting the foot in such a manner as to alleviate stress and strain

upward through the legs and into the lower back caused by improper foot posture (column 3, line 36 et seq.). Kantro discloses as part of the balancing insole a cushion 20 which, as can be seen in Figure 2, is in the shape of a disk, and the reference teaches that this element is made of polymeric foam having density higher than that of the surrounding insole (column 5, lines 62-64).

The appellant argues on page 8 of the Brief that the Kantro disc is a cushion of polymeric foam, whereas the appellant's claims require that the disc be rigid, and therefore Kantro fails to disclose or teach this feature of the invention. This position is supported by Mr. Epstein's affidavit of July 8, 1999. However, while claim 7 requires that the disc be "substantially rigid," there is no such requirement in claim 1, and therefore, as to claim 1, this argument and the affidavit are not persuasive since they are directed to a limitation that is not in the claim. Further in this regard, as we have noted above, the appellant has stated in the specification that the disc may be of flexible material such as foam, and polymeric foam is specified by Kantros as a material from which the disc can be made (column 5, lines 61 and 62).

On that same page the appellant further argues that the rejection is defective because Kantro does not teach or suggest that the disc member be securable to a desired location and oriented at any desired angle through 360°. We first point out that claim 1 is directed to a balancing disc and not to a disc in combination with an orthotic

device. Kantros discloses a disc for use in an orthotic device, and while the locations and orientation disclosed in the patent may not be the same as those contemplated by the appellant for use with the claimed disc and mentioned in claim 1, Kantros teaches securing the disc by means of a pressure adhesive (column 6, lines 1 and 2), and therefore it would be capable of being secured to an orthotic foot device in a plurality of incremental locations through 360°, as is set forth in claim 1.

The appellant also argues that “[a]t best, the combination of *Kantro* with *Cherniak* would provide a combination wherein the *Kantro* disc (20) is rigid, and of uniform thickness” (Brief, page 11). However, *Kantro* states that the disc 20 “is tapered alone [sic, along] an axis directed at an angle relative to the longitudinal axis of the insole along line 20a” (column 4, lines 46 and 47) which, in the absence of evidence to the contrary, would indicate that it has surfaces inclined at an angle to one another, as is required by claim 1. In this regard, the appellant has acknowledged on page 11 of the Brief that the *Kantro* disc is tapered (line 22).

In conclusion, the arguments presented by the appellant have not convinced us that Kantros fails to disclose or teach all of the structure recited in claim 1. Anticipation being the epitome of obviousness (see In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982)), we will sustain the rejection of claim 1 on the basis of Kantros, considering Cherniak merely to be confirmatory of the fact that discs such as those

disclosed by Kantros were known to be made of compressible or non-compressible material.

With regard to claims 7 and 8, however, we reach the opposite conclusion. Independent claim 7 requires, inter alia, that the upper and lower surfaces of the wedge member be angularly inclined with respect to each other by an angle of "about 2° to about 6°." The examiner has asserted, with regard to this requirement, "[n]ote that heel cushion 19 is **tapered** at about 5 degrees. The only reasonable conclusion (by comparison of column 4, line 32 to line 46) is that the cushion 20 is also exactly **tapered** as described for cushion/disc 19" (Answer, page 3). This position is untenable for two reasons. First, the examiner has not directed us to, and we have not found on our own, where Kantros teaches any particular angle of taper for heel cushion 19, much less that it is about 5 degrees. Second, there is no teaching in the reference that the taper of disc 20 is the same as that of heel cushion 19, and to conclude in the absence of such instruction that the tapers are the same is merely conjecture. This deficiency is not cured by consideration of the teachings of Cherniak.

Thus, the combined teachings of Kantros and Cherniak fail to establish a prima facie case of obviousness with regard to the subject matter recited in claims 7 and 8, and the rejection of these claims as being unpatentable over Kantros and Cherniak is not sustained.

Claim 1 also stands rejected as being unpatentable over Kantros in view of Cherniak, taken further with Shaw, Smith and Marc. Applying the reasoning advanced above with regard to the rejection of claim 1 on the basis of Kantros and Cherniak, we will also sustain the alternative rejection of claim 1 as being unpatentable over Kantros, Cherniak, Shaw, Smith and Marc.

As for the like rejection of claims 7 and 8, the examiner has opined that Shaw teaches wedge members having a taper of about 3°, Marc of about 2°, and Smith about 4°, concluding it therefore would have been obvious to one of ordinary skill in the art to taper the Kantros discs to an angle of about 4° to about 6°. On the basis of reasoning analogous to that applied against the other rejection of claims 7 and 8, we also will not sustain this rejection. First of all, there is no support for these values in the specification of Shaw, Smith or Marc. Second, none of these references disclose tapered discs.

CONCLUSION

The rejection of claim 1 as being unpatentable over Kantro in view of Cheriak is sustained.

The rejection of claims 7 and 8 as being unpatentable over Kantro in view of Cheriak is not sustained.

The rejection of claim 1 as being unpatentable over Kantro in view of Cheriak, Shaw, Smith and Marc is sustained.

The rejection of claims 7 and 8 as being unpatentable over Kantro in view of Cheriak, Shaw, Smith and Marc is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

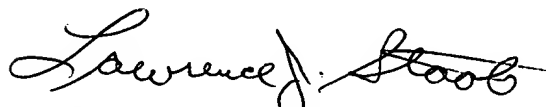
AFFIRMED-IN PART



IRWIN CHARLES COHEN
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge

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